

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Mi *et al.*

Application No.: 10/553,685

§ 371 Date: November 1, 2006

For: **Nogo Receptor Binding Protein**

Confirmation No.: 4041

Art Unit: 1656

Examiner: CARLSON, Karen C.

Atty. Docket: 2159.0440003/EJH/CLD

**Request for Reconsideration and Application for Patent Term Adjustment
Pursuant to 37 C.F.R. § 1.705(b)**

Attn: Mail Stop Issue Fee

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §§ 1.705(b)(1) and (b)(2), Applicants provide a concise statement of facts involved, as well as payment of fees set forth in 37 C.F.R. § 1.18(e).

Statement of the Facts:

Applicants hereby request that the Patent Term Adjustment for the captioned application be corrected to allow an addition of 14 days to the current Patent Term Adjustment of -63 days, the correct total Patent Term Adjustment, to date, being -49 days.

The U.S. Patent and Trademark Office (PTO) mailed a Notice of Allowance and Fee(s) Due on November 2, 2009. This Notice contained a determination of Patent Term Adjustment under 35 U.S.C. § 154(b), which indicated that the Patent Term Adjustment (PTA) was based on a PTO delay of 89 days (37 C.F.R. § 1.703(a)) reduced by an Applicant delay of 152 days (37 C.F.R. § 1.704(b)), which is a total of -63 days of PTA.

Applicants believe that the PTO delay of 89 days should be increased by 14 days under 37 C.F.R. § 1.703(a). While the PTA accrued under 35 U.S.C. § 154(b)(1)(A) will still be negative with this additional 14 days of PTO delay, as of February 2, 2010, Applicants are already entitled to 473 days of PTO delay under 35 U.S.C. § 154(b)(1)(B). Therefore, since the total PTA will be determined by adding the PTO

delay under 35 U.S.C. § 154(b)(1)(A) and the of PTO delay under 35 U.S.C. § 154(b)(1)(B)¹ and subtracting any Applicant delay under 35 U.S.C. § 154(b)(2)(C), Applicants wish to preserve their entire entitlement to PTA.

PTO delay under 37 C.F.R. §1.702(a) and 35 U.S.C. §154(b)(1)(A)

The PAIR system indicates PTO delay as (1) a delay of 12 days caused by the PTO's issuance of a Notice to Comply on March 25, 2008 in response to Applicants' Reply to Unity of Invention filed on November 13, 2007 and (2) a delay of 77 days caused by the PTO's issuance of a Non-Final Rejection on November 24, 2008 in response to Applicants' Preliminary Amendment filed on May 8, 2008.

In contrast, Applicants submit that the PTO delay resulting from the issuance of a Notice to Comply in response to Applicants filing of a Reply to the Unity of Invention should be 26 days and not 12 days. Applicants filed a Reply to Unity of Invention on November 13, 2007. In response, the PTO issued a Notice to Comply on March 25, 2008. However, on April 8, 2008, the PTO issued a second Notice to Comply and requested that the Notice to Comply mailed on March 25, 2008 be vacated. Thus, Applicants submit that because the Notice to Comply mailed on March 25, 2008 was vacated, it did not constitute an action by the PTO. Therefore only the second Notice to Comply, mailed on April 8, 2008, should be used to calculate PTO delay. April 8, 2008 is 26 days after the date beginning four months after Applicants filed the Reply to Unity of Invention on November 13, 2007. Thus, Applicants submit that any PTO delay resulting from the mailing of a Notice to Comply in the present case should be 26 days and not 12 days.

¹ According to the PTO, knowledge of the date the patent will issue is required to calculate the amount of patent term adjustment based on 35 U.S.C. § 154(b)(1)(B). Therefore reconsideration of patent term adjustment indicated in the patent as it relates to the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) is **not** considered a matter that could have been raised in an application for patent term adjustment under 37 CFR 1.705(b). A request for reconsideration of patent term adjustment calculation based on the three-year pendency provision of 35 U.S.C. § 154(b)(1)(B) will be considered timely under 37 CFR 1.705(d) if filed within two months of the date the patent issued. *See* David J. Kappos Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office: Notice Concerning Calculation of the Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) involving International Applications Entering the National Stage Pursuant to 35 U.S.C. § 371 (September 9, 2009).

Applicants' Delay Under 37 C.F.R. §1.704(b)

Applicants believe that the information recorded in the PAIR system correctly indicates Applicants' delay under 37 C.F.R. §1.704(b) as (1) a delay of 95 days caused by Applicants because of the filing of an IDS on August 11, 2008, 95 days after Applicants filed a Preliminary Amendment on May 8, 2008 (37 C.F.R. § 1.704(c)(8)) and (2) a delay of 57 days due to filing of a corrected Reply to Non-Final Rejection on April 21, 2009, 57 days after filing a Reply to a Non-Final Rejection on February 23, 2009 (37 C.F.R. § 1.704(c)(7)). Thus, it is believed that the delay by Applicants was correctly calculated as a total of 152 days.

The above-captioned application is not subject to a terminal disclaimer. *See*, 37 C.F.R. § 1.705(b)(2)(iii).

In addition, the Applicants do not believe that prior to February 2, 2010 there were any circumstances during the prosecution of the application that constitute a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704(c) beyond the above mentioned delay of 152 days under 37 C.F.R. §1.704(b).

The Precise Relief Requested:

In view of above, Applicants are entitled, to date, to a patent term adjustment of a total of -49 days. In particular, the total PTO delay of 89 days is incorrect, and the correct PTO delay is 103 days. Thus, Applicants believe a PTA of -49 days (103 days reduced by 152 days) is correct. Upon the addition of PTO delay under 35 U.S.C. § 154(b)(1)(B) following issuance of the patent, Applicants will be entitled to at least 424 days (473 days of PTO delay under 35 U.S.C. § 154(b)(1)(B) plus 103 days of PTO delay under 35 U.S.C. § 154(b)(1)(A) minus 152 days Applicants' delay under 35 U.S.C. § 154(b)(2)(C)), so a proper accounting of delay under 35 U.S.C. § 154(b)(1)(A) is relevant.

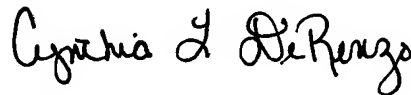
In accordance with 37 C.F.R. § 1.705(b)(1), the fee set forth in 37 C.F.R. § 1.18(e) is provided in our accompanying Credit Card Payment Form PTO-2038. It is not believed that additional fees are required beyond those that may otherwise be provided in documents accompanying this paper. However, if additional fees are required, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

If it is believed, for any reason, that personal communication will expedite consideration of this Request, please do not hesitate to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Request is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: 2/2/10

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